



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,751	12/04/2003	Chris Gorman	SDS-8394	7607
23334	7590	08/22/2006	EXAMINER	
FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487			LAUX, JESSICA L	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/727,751	GORMAN, CHRIS
	Examiner	Art Unit
	Jessica Laux	3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 June 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 21-24 is/are allowed.
- 6) Claim(s) 1-13, 15, 16 and 18-20 is/are rejected.
- 7) Claim(s) 14 and 17 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 June 2006 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Drawings

The drawings were received on June 30, 2006. These drawings are accepted.

Response to Arguments

Applicant's arguments filed June 30, 2006 have been fully considered but they are not persuasive.

Applicant argues on page 13 of the remarks that the grooves and ridges of Hoh et al. do not render the arms as wave-shaped extending arms, nor do they allow the shim to compress. Examiner asserts that the grooves and ridges of Hoh et al. do constitute wave-shaped extending arms as the grooves and ridges equate to the troughs and peaks of a wave-shaped body and the arms do extend in that they continue for a specified distance (where extend is defined by the Compact Oxford English Dictionary, www.askoxford.com, as "... 3. occupy a specified area or continue for a specified distance"). Further applicant's arguments as the shim compressing are moot as that is not a feature of claims 1, 6-7, 10-12 and 15.

Applicant argues on page 14 of the remarks that Hoh et al. does not disclose wave-shaped extending arms, wherein a trough and peak is parallel to a junction between the first portion and the second portion. Examiner disagrees as the slot between the first portion and the second portion is a junction between the two portions and it extends in a direction parallel to the trough and peak.

Applicant argues on page 15 of the remarks that Colt does not disclose a pair of wave-shaped extending arms. Examiner maintains that Colt does disclose wave-shaped extending arms as depicted in Figure 2 where elements 16 and 14 have a trough (generally indicated at 11) and extend upward into a peak (the uppermost portion of elements 14 and 16) and then have a trough again after the peak. Further the wave-shaped arms do extend in that they continue for a specified distance (where extend is defined by the Compact Oxford English Dictionary, www.askoxford.com, as "... 3. occupy a specified area or continue for a specified distance".

Applicant argues the rejection of claim 18 on page 16 of the remarks. Examiner asserts that Hoh et al. does discloses wave-shaped extending arms where the peak and trough extend parallel to a junction between the first portion and the second portion as stated above. Further examiner notes that applicant has not challenged or traversed the official notice that is well known in the art to insert shims in a gap between two elements. Therefore the official notice is now taken as admitted prior art.

Applicant argues on page 17 of the remarks that the prior art of Hoh et al. taken alone and/or in view of Grove Products, Inc does not suggest, teach or mention a wave-shaped body, or a pair of wave-shaped extending arms, wherein a direction of the wave is away from the end. Examiner maintains that Hoh et al. does teach a wave-shaped body and a pair of wave-shaped extending arms as stated above. Further applicants argument "... direction of the wave is away from the end" is moot as that is not a feature of claims 1 and 10 as applicant has erroneously indicated.

Applicant argues on page 18 of the remarks that Hartin fails to show wave-shaped extending arms, wherein a direction of the wave is away from the end. Examiner maintains that Colt does show the claimed features as stated above, and further Examiner directs applicant to the previous office action which Hartin was used regarding the feature of the through-hole and not the wave-shaped extending arms. Therefore applicant's argument of Hartin is moot, as examiner has not used Hartin in regards to the disputed features as applicant has indicated in the arguments.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6-7, 10-12, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoh et al. (4232068).

In regards to claim 1: Hoh et al. teaches a shim (1), comprising a body with a first portion (2) and a second portion (3); and a slot (Figure 2) dividing the first portion of said body into a pair of wave-shaped extending arms (2 and 3), wherein a trough and a peak (Col. 3, lines 49-52) of the wave-shaped extending arms is parallel to a junction between the first portion and the second portion.

In regards to claim 2: The shim according to in claim 1 above, which further comprises a tab (5) attached to said body at a side opposite said wave-shaped extending arms.

In regards to claim 3: The shim according to claim 2 above, wherein said tab is attached to said body via an area of reduced body material (6) at a junction point between said tab and said body.

In regards to claim 6: The shim according to claim 1 above, wherein at least one area of reduced body material exists at corresponding locations along each of said wave-shaped extending arms (2a and 3a).

In regards to claim 7: The shim according to claim 1 above, wherein said body is comprised of a single piece of material (Figure 3).

In regards to claim 10: Hoh et al. teaches a shim assembly comprising a plurality of bodies (Figure 5), each with a first portion (2) and a second portion (3) and formed with a slot dividing the first portion into a pair of wave-shaped extending arms, wherein a trough and a peak (Col. 3, lines 49-52) of the wave-shaped extending arms in parallel to a junction between the first portion and the second portion and each of said wave-shaped bodies are removably attached to at least one other one of said wave-shaped body (Figure 5 and Col. 4, line 3).

In regards to claim 11: The shim assembly according to claim 10 above, which further comprises a tab (5) attached to each of said bodies at a side opposite said wave-shaped extending arms (Figure 5).

In regards to claim 12: The shim assembly according to claim 11 above, wherein said tab is attached to said body via an area of reduced body material (6) on each said body at a junction point between each said tab and each said body.

In regards to claim 15: The shim assembly according to claim 10, wherein at least one area of reduced body material exists at corresponding locations along each of said wave-shaped extending arms (2a and 3a; Figure 5).

Claims 1-2 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Colt (1552912).

In regards to claims 1: Colt teaches a shim, comprising a wave-shaped body (as depicted in Figure 2) formed with a slot (8) dividing a portion of said body at an end thereof into a pair of wave-shaped extending arms (12 and 13).

In regards to claim 2: The shim according to in claim 1 above, which further comprises a tab (10) attached to said body at a side opposite said wave-shaped extending arms.

In regards to claim 9: The shim according to claim 1 above, wherein at least one of said extending arms has a first surface and a second surface opposite said first surface, and said extending arm (12 or 13) is formed with at least one through-hole (17) running from said first surface to said second surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoh et al. (4232068).

Claim 18 merely recites the obvious method of inserting the shim of claim 1 above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to insert a shim into a gap as it is well known in the art to insert shims in a gap between two elements.

In regards to claim 19, Hoh et al. teaches the tab portion to be removable after proper location of the shim.

Claim 20 merely recites the obvious method of removing the portions after insertion. Further, Hoh et al teaches that the leg portions may be broken off to adjust the length of the legs (abstract), but is silent in regards to when to break them off. It would be obvious to one of ordinary skill in the art at the time the invention was made to break off extra length after insertion to ensure the shim is of the correct length.

Claims 4, 8, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoh et al (4232068) in view of Grove Products Inc.

In regards to claims 4 and 13: Hoh et al. teaches a shim as in claims 1-2 and 10-11 above having an area of reduced material at the tab for breaking off the tab after insertion, but does not teach the shim to have a groove being a complete void of material extending from the edge of the tab toward the center region of the tab. Grove Products Inc. teaches a shim having a tab with an edge and a perpendicular surface

with a parallel surface wherein there is a groove, being a complete void of material extending from the edge in a direction towards a center of the tab, for ease in breaking off the tab after insertion. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shim of Hoh et al. to have a groove as in the shim of Grove Products Inc. as such a modification would make for a more defined break-off point with less material attaching the two members together.

In regards to claims 8 and 16: Hoh et al. teaches a shim as in claims 1 and 10 above having an area of reduced material at the legs of the shim for breaking off the extra length of the leg after insertion, but does not teach the shim to have a groove being a complete void of material extending from the edge of the tab toward the center region of the leg. Grove Products Inc. teaches a shim having a leg with an edge and a perpendicular surface with a parallel surface wherein there is a groove, being a complete void of material extending from the edge in a direction towards a center of the leg, for ease in breaking off the extra length of the leg after insertion. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shim of Hoh et al. to have a groove as in the shim of Grove Products Inc. as such a modification would make for a more defined break-off point with less material attaching the two members together.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colt (1552912) in view of Hartin (DES 423909). Colt teaches a shim as in claim 1 above, where the shim has through-holes for securing the shim to an element, but does not teach the through-hole being located in the tab portion of the shim. Hartin teaches a

shim having a tab with a through-hole. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shim of Colt to have a through-hole located in the tab portion as such a modification would allow for easier access to the hole for securing the shim to an element.

Allowable Subject Matter

Claims 14 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 21-24 are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 8:30am to 4:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JL
08/07/2006


N. Slack
SPE